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10/561,246	05/01/2006	Hideki Sato	31238-226496	5994
26694	7590	07/12/2007		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER CHEN, KEATH T	
			ART UNIT	PAPER NUMBER
			1709	
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			07/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/561,246

Applicant(s)

SATO ET AL.

Examiner

Keath T. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/19/2005.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

US 5009922, the primary reference of this rejection, is a patent family of JP2011160, admitted prior art by applicant.

#### **Claim interpretation**

For claim 2, the "and" at the end of line 13 can have multiple meanings. One meaning requires that the actions described in lines 8-13 (stepwise increase of electric power) has to be finished in time before the actions described in lines 14-19 (converging, moving and expanding the plasma) to occur. Or it can mean that these two groups of actions can be simultaneous and/or interleaved.

Claim 2 will be interpreted as inclusive of any of these possibilities, the broadest interpretation.

#### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: At line 10, after "(9)", there is a dust particle or a period in the scanned claim document. Appropriate correction is required.

Claim 1 will be examined assuming it is a dust particle after "(9)".

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harano et al. (US 5009922, hereafter '922), further in view of Ichikawa et al. (JP3193868, hereafter '868) and Shintani et al. (JP4350157, hereafter '157).

'922 teaches some limitations of claim 1:

A production device (Fig. 3, #1) for producing a multicomponent film from a vaporizing material (#3) of an alloy containing at least two sorts of metals or intermetallics compound (col. 10, lines 24-26) by a melting-evaporation type ion plating method (col. 1, lines 20-24) which melts and evaporates the material from a single crucible or hearth (#4) with use of plasma (#14) converged by an electric field or a magnetic field, the device having an electric power supply unit (#7) for melting and evaporating the material and a plasma control unit (#15) for controlling the electric field or magnetic field.

'922 does not teach other limitation of claim 1:

Characterized in that said electric power supply unit (#7) is a sequentially increased electric power supply unit which supplies first electric power necessary to evaporate the material (#3) and then supplies electric power increased stepwise from

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the first electric power at predetermined intervals repeatedly up to necessary maximum electric power to sequentially melt an unmelted portion of the material, and said plasma control unit (#15) performs plasma control for converging the plasma (#14) into a first plasma region necessary to evaporate the material (#3) and performs plasma control for continuously and sequentially moving and expanding the plasma from the first plasma region up to the maximum plasma region to sequentially melt the unmelted portion.

'868 is an analogous art in the field of forming a transparent conductive (English abstract, line 2; '922, ITO formation, col. 10, lines 48-50), particularly in solving the problem of uniformity (English abstract, last two lines; '922, col. 14, lines 9-13). '868 teaches a method of increasing power supply (Fig. 2) to improve the uniformity of the thin film. Notice the region between 2 and 3 in the x-axis (the ramp portion) can be represented as many small steps of incremental increase of power.

'157 is an analogous art in the field of PVD for producing a thin film (English abstract), particularly in solving the problem of uniformity. '157 teaches a way to control the size of plasma focus area (Fig. 2) by moving in the radial direction to improve film forming efficiency ([0015]) and which direction to move depends on application.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have combined '868 and '157 with '922. Specifically, to have adopted the power increase steps as taught in Fig. 2 of '868 and applied to the apparatus as taught in Fig. 3 of '922, for the purpose of improving film uniformity; and to have adopted the magnets focus control device taught in Fig. 2 of '157 to replace the single magnet (#5) of Fig. 3 of '922, for the purpose of improving film forming efficiency,

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with reasonable expectation of success. With only two directions to test (gradually move the magnets 6a-d in or out), and the common knowledge that the components of a bimetal alloy vaporize at different rates, it would be obvious for a person of ordinary skills in the art to figure out expanding the plasma region would have produced more uniform film.

Claim 2 is rejected with substantially the same reason as claim 1 rejection above.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over '922, '868, and '157, further in view of Shima et al. (JP 2001001202, hereafter '202).

'922, '868, '157, together, teaches all limitations of claim 2, as discussed above.

'922, '868, '157, together, do not teach the limitation of claim 3:

A cutting tool base material of a high-speed tool steel, a die steel, a cemented carbide, a cermet or the like and a coating film of a nitride, a carbide, a boride, an oxide or a silicide containing a plurality of metallic elements and formed on the base material by the method of claim 2.

'202 is an analogous art in the field of PVD (ion plating, English translation, [0004], line 9). '202 requires a thin film formation apparatus and method for the thin film (including nitride, abstract) formation on tools ([0001], last line, high degree-of-hardness steel) to improve the cutting life and oxidation resistance of the tool.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have combined '202 with '922. Specifically, to have applied the method taught by '922, '868, and '157, to cutting tools as taught by '202, for the

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purpose of improving cutting life and oxidation resistance, with a reasonable expectation of success.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 10/561248.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 are combinations of claims 1-6 of '248.

5. Claim 3 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 8 of copending Application No. 10/561248. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keath T. Chen whose telephone number is 571-270-1870. The examiner can normally be reached on M-F, 8:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on 571-272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kc

K.C.

  
MICHAEL B. CLEVELAND  
SUPERVISORY PATENT EXAMINER